



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,434	02/10/2004	Peter S. Yang JR.	012.43208X00	1669

20457 7590 08/06/2004

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-9889

EXAMINER

STULTZ, JESSICA T


ART UNIT

PAPER NUMBER

2873

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/774,434	Applicant(s) YANG, PETER S.	
	Examiner Jessica T Stultz	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>0204</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION***Double Patenting***

Claims 1-4 and 6-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,999,336 in view of Galiani. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to one having ordinary skill in the art at the time the invention was made for the cardholder to be made of one piece of plastic material as disclosed below.

Regarding independent claim 1, Yang 5,999,336 (herein referred to as Yang '336) discloses a cardholder made of plastic configured as a rectangle-shaped cardholder with dimensions approximating a standardized card carried by a person, wherein the plastic material contains at least two folded edges which form at least a pair of tracks of the cardholder for slipping on and off one or more standardized cards (Claims 1 and 4), but does not specifically disclose that the cardholder is made of one piece of plastic material. However, it has been held that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering design. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for cardholder of Yang '336 to be made of one piece of plastic material since the use of a one piece construction would be a matter of obvious engineering design. Nevertheless, Galiani teaches of a magnifying container, including a fresnel lens made of one piece of plastic material for the purpose of providing a flexible transparent polymer material for the magnifying holder (Column 4, line 60-Column 5, line 23). Therefore it

Art Unit: 2873

would have been obvious to one having ordinary skill in the art at the time the invention was made for cardholder of Yang '336 to be made of one piece of plastic material since Galiani teaches of a magnifying container, including a fresnel lens, made of one piece of plastic material for the purpose of providing a flexible transparent polymer material for the magnifying holder.

Regarding claims 2-4, Yang '336 and Galiani disclose and teach of a cardholder as shown above and Yang '336 further discloses the limitations therein (Claims 1 and 10 of Yang '336).

Regarding claims 6-7, Yang '336 and Galiani disclose and teach of a cardholder as shown above and Yang '336 further discloses the limitations therein (Claims 1-3, 5, and 10 of Yang '336).

Claims 5 and 8-25 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,999,336 in view of Galiani (as shown above in claims 1-4 and 6-7) and further in view of Finkelstein et al US 6,176,430 (herein referred to as Finkelstein et al '430).

Regarding claims 5 and 8-25, Yang '336 and Galiani discloses a plastic cardholder comprising the same limitations as the present invention as shown above, wherein Galiani further teaches of the cardholder including tab-like extensions (Column 5, lines 24-54, wherein the tab-like extensions are "26" and "28", Figures 1-4), but do not specifically disclose that the plastic material is polyester, PVC, or polycarbonate, that the plastic sheet is covered by an opaque coating using a mask except on the viewing portion, or that the plastic material is heated to form the tracks from tab-like extensions being bent by 180 degrees. Finkelstein et al '430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an

Art Unit: 2873

amorphous material (Column 7, lines 9-32, wherein the card "48" is made of polyester, PVC, or polycarbonate, Figure 6), wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens (Column 10, lines 26-34, wherein the opaque layer "304" is printed on using a silk screen, i.e. mask, Figures 17-19), and wherein the plastic material is heated for the purpose of obtaining the desired shape (Column 9, line 66-Column 10, line 9, Figure 15). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the cardholder of Yang '336 and Galiani to further include the plastic material being polyester, PVC, or polycarbonate, wherein the plastic sheet is covered by an opaque coating using a mask except on the viewing portion, and wherein the plastic material is heated to form the tracks from tab-like extensions being bent by 180 degrees since Finkelstein et al '430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an amorphous material, wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens, and wherein the plastic material is heated for the purpose of obtaining the desired shape.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 2873

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang 5,999,336 (herein referred to as Yang '336) in view of Galiani.

Regarding independent claim 1, Yang 5,999,336 (herein referred to as Yang '336) discloses a cardholder made of plastic configured as a rectangle-shaped cardholder with dimensions approximating a standardized card carried by a person, wherein the plastic material contains at least two folded edges which form at least a pair of tracks of the cardholder for slipping on and off one or more standardized cards (Claims 1 and 4), but does not specifically disclose that the cardholder is made of one piece of plastic material. However, it has been held

Art Unit: 2873

that the use of a one piece construction instead of the structure disclosed in the prior art would be merely a matter of obvious engineering design. *In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for cardholder of Yang '336 to be made of one piece of plastic material since the use of a one piece construction would be a matter of obvious engineering design. Nevertheless, Galiani teaches of a magnifying container, including a fresnel lens made of one piece of plastic material for the purpose of providing a flexible transparent polymer material for the magnifying holder (Column 4, line 60-Column 5, line 23). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for cardholder of Yang '336 to be made of one piece of plastic material since Galiani teaches of a magnifying container, including a fresnel lens, made of one piece of plastic material for the purpose of providing a flexible transparent polymer material for the magnifying holder.

Regarding claims 2-4, Yang '336 and Galiani disclose and teach of a cardholder as shown above and Yang '336 further discloses the limitations therein (Claims 1 and 10 of Yang '336).

Regarding claims 6-7, Yang '336 and Galiani disclose and teach of a cardholder as shown above and Yang '336 further discloses the limitations therein (Claims 1-3, 5, and 10 of Yang '336).

Claims 5 and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yang '336 in view of Galiani and further in view of Finkelstein et al '430.

Regarding claims 5 and 8-25, Yang '336 and Galiani discloses a plastic cardholder comprising the same limitations as the present invention as shown above, wherein Galiani further

Art Unit: 2873

teaches of the cardholder including tab-like extensions (Column 5, lines 24-54, wherein the tab-like extensions are “26” and “28”, Figures 1-4), but do not specifically disclose that the plastic material is polyester, PVC, or polycarbonate, that the plastic sheet is covered by an opaque coating using a mask except on the viewing portion, or that the plastic material is heated to form the tracks from tab-like extensions being bent by 180 degrees. Finkelstein et al ‘430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an amorphous material (Column 7, lines 9-32, wherein the card “48” is made of polyester, PVC, or polycarbonate, Figure 6), wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens (Column 10, lines 26-34, wherein the opaque layer “304” is printed on using a silk screen, i.e. mask, Figures 17-19), and wherein the plastic material is heated for the purpose of obtaining the desired shape (Column 9, line 66-Column 10, line 9, Figure 15). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the cardholder of Yang ‘336 and Galiani to further include the plastic material being polyester, PVC, or polycarbonate, wherein the plastic sheet is covered by an opaque coating using a mask except on the viewing portion, and wherein the plastic material is heated to form the tracks from tab-like extensions being bent by 180 degrees since Finkelstein et al ‘430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an amorphous material, wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens, and wherein the plastic material is heated for the purpose of obtaining the desired shape.

Claims 1-4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galiani.

Regarding independent claim 1, Galiani discloses a cardholder made of a one piece plastic configured as a rectangle-shaped cardholder (Column 4, line 60-Column 5, line 23, wherein the cardholder “10” is rectangular and made of one piece of plastic material, Figure 1) wherein the plastic material contains at least two folded edges which form at least a pair of tracks of the cardholder for slipping on and off one or more cards (Column 5, lines 24-54, wherein the tracks are the edges of frame structure “22” wherein the pivot body “30” aids in slipping cards into or out of the holder, Figures 1-4), but does not specifically disclose that the cardholder has dimensions to approximate a standardized card carried by a person. However, it has been held that a mere change in the size of a components disclosed in the prior art would be merely a matter of obvious engineering design. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955). Therefore it would have been obvious for the cardholder of Galiani to further include dimensions to approximate a standardized card carried by a person since it has been held that a mere change in the size of a components disclosed in the prior art would be merely a matter of obvious engineering design.

Regarding claims 2-4, Galiani further discloses that the cardholder include J-shaped tracks (See Figures 1-4) wherein the plastic material includes a magnifier view portion constituted by fresnel contour lines stamped on either side of the viewing portion of the cardholder (Column 6, lines 16-24, wherein the fresnel magnifying lens is “62”, Figures 1-4).

Regarding claims 6-7, Galiani further discloses that the size, shape, and position of the viewing portion is determined on the basis of the level of viewing desired, although limited by

Art Unit: 2873

the surface dimension of the cardholder and that the viewing portion covers a rectangular-shaped area having its elongated sides extending parallel to the pair of tracks (Column 4, line 60-Column 5, line 54 and shown in Figures 1-4, wherein the viewing portion is based on the printed material to be read and runs parallel to frame “22”).

Claims 5 and 8-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Galiani in view of Finkelstein et al ‘430.

Regarding claims 5, 8, 12-14, and 21-25 Galiani discloses a plastic cardholder as shown above including tab-like extensions (Column 5, lines 24-54, wherein the tab-like extensions are “26” and “28”, Figures 1-4), but does not specifically disclose that the plastic material is polyester, PVC, or polycarbonate, that the plastic sheet is covered by an opaque coating using a mask except on the viewing portion, or that the plastic material is heated to form the tracks from tab-like extensions bent by 180 degrees. Finkelstein et al ‘430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an amorphous material (Column 7, lines 9-32, wherein the card “48” is made of polyester, PVC, or polycarbonate, Figure 6), wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens (Column 10, lines 26-34, wherein the opaque layer “306” is printed on using a silk screen, i.e. mask, Figures 17-19), and wherein the plastic material is heated for the purpose of obtaining the desired shape (Column 9, line 66-Column 10, line 9, Figure 15). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made for the cardholder of Galiani to further include the plastic material being polyester, PVC, or polycarbonate, wherein the plastic sheet is covered by an opaque coating

Art Unit: 2873

using a mask except on the viewing portion, and wherein the plastic material is heated to form the tracks from tab-like extensions being bent by 180 degrees since Finkelstein et al '430 teaches of a card with a fresnel lens made of polyester, PVC or polycarbonate for the purpose of using an amorphous material, wherein the card is covered by an opaque coating using a mask except on the viewing portion for the purpose of providing the necessary graphics on the plastic and forming a region for the magnifying lens, and wherein the plastic material is heated for the purpose of obtaining the desired shape.

Regarding claims 9-11, 15-20, Galiani and Finkelstein et al '430 disclose and teach of a cardholder as shown above and Galiani further discloses that the cardholder include J-shaped tracks and have curved corners to hold the cards (Figures 1-4) wherein the plastic material includes a magnifier view portion constituted by fresnel contour lines stamped on either side of the viewing portion of the cardholder (Column 6, lines 16-24, wherein the fresnel magnifying lens is "62", Figures 1-4) wherein the size, shape, and position of the viewing portion is determined on the basis of the level of viewing desired, although limited by the surface dimension of the cardholder and that the viewing portion covers a rectangular-shaped area having its elongated sides extending parallel to the pair of tracks (Column 4, line 60-Column 5, line 54 and shown in Figures 1-4, wherein the viewing portion is based on the printed material to be read and runs parallel to frame "22") and including cut-away portions to easily remove the card from the holder (Column 5, lines 24-54, wherein the tracks are the edges of frame structure "22" wherein the pivot body "30" aids in slipping cards into or out of the holder through an opening in the body, Figures 1-4).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Spector, DeField, and Tiscione et al are cited as being some similar structure to the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica T Stultz whose telephone number is (571) 272-2339. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Epps can be reached on 571-272-2328. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jessica Stultz
Patent Examiner
AU 2873
August 4, 2004



JORDAN SCHWARTZ
PRIMARY EXAMINER